

## **REMARKS**

This paper is submitted in reply to the Office Action dated April 11, 2008, within the three-month period for response. Reconsideration and allowance of all pending claims are respectfully requested.

In the subject Office Action, claims 38-62 and 65-75 were once again rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,029,180 to Murata et al. The Examiner has additionally added new rejections to the claims, including an obviousness-type double patenting rejection in view of U.S. Patent No. 6,021,418, a rejection of claim 61 under 35 U.S.C. §101 and a rejection under 35 U.S.C. §112, first paragraph with respect to claims 38, 50, 61 and 75.

Applicant respectfully traverses the Examiner's rejections to the extent that they are maintained.

Applicant has amended claim 61 herein, and Applicant respectfully submits that no new matter is being added by the above amendments, as the amendments are fully supported in the specification, drawings and claims as originally filed. Applicant also notes that the amendments made herein are being made only for facilitating expeditious prosecution of the aforementioned claimed subject matter. Applicant is not conceding in this application that the originally claimed subject matter is not patentable over the art cited by the Examiner, and Applicant respectfully reserves the right to pursue this and other subject matter in one or more continuation and/or divisional patent applications.

As an initial matter, Applicant thanks the Examiner for the courtesy extended in a telephone call with the undersigned on April 17, 2008 regarding the finality of the present Office Action. In the telephone call, Applicant noted that the new double patenting and §101 rejections, which were not necessitated by Applicant's amendments, precluded making the Office Action final. As a result, the Examiner agreed to withdraw the finality of the Office Action, and asked that Applicant make the withdrawal of the finality of record in this paper. Applicant therefore respectfully requests that the finality of the Office Action be withdrawn, and that this paper be treated as a response to a non-final action.

Now turning to the rejections, and in particular to the double patenting rejection, while Applicant traverses the rejection on the merits, Applicant has nonetheless enclosed herewith a terminal disclaimer to overcome the rejection and facilitate an early allowance of this application. Withdrawal of the double patenting rejection is therefore respectfully requested.

Next, with regard to the §101 rejection of claim 61, the Examiner asserts that the claim is non-statutory because it claims software per se. Applicant has amended claim 61 to clarify that the program product includes “a recordable type media bearing said computer program.” Support for this amendment may be found, for example, at page 11, lines 16-18 and claim 24 of the Application as originally filed. It is Applicant’s understanding of the Office’s current guidelines that a program product in which a program is borne on a physical, tangible media such as a recordable type media is considered to be statutory. In contrast to the Examiner’s statement, the claim does not merely claim software per se, so Applicant respectfully requests that the rejection be withdrawn. In the alternative, should the Examiner desire any alternative language that the Examiner believes would place the claim in a more appropriate form, the Examiner is encouraged to contact the undersigned to discuss a suggested amendment.

Next, with regard to the §112 rejection, and in particular with regard to the objection to the language “after commencing to download the file,” Applicant provided a citation to the support for this language in the prior response. In particular, as Applicant noted previously, the concept of “dynamically prompting” is defined at page 12, lines 20-21 of the Application as originally filed, which states that “[I]n the preferred embodiment, the request to the web user occurs dynamically, e.g., automatically after the HTML document is downloaded.” Additionally support may be found, for example, in Fig. 6, blocks 906 and 908, which illustrate respectively commencing to download a file, and then dynamically prompting after download of the file has been commenced. The Examiner’s attention is also directed to original claim 1, among other claims, which specifically recites “commencing to download a file.”

The rejected claims were amended in the last response to clarify that the “dynamic prompting” occurred “after commencing to download the file,” which is entirely consistent with the supporting language in the specification. Moreover, Applicant chose to recite “after commencing to download the file,” rather than alternative language, because the concept of “commencing to download the file” was already recited in the rejected claims, and was even found in the claims as originally filed.

The passage at page 12 of the specification establishes a temporal relationship between downloading a file and dynamically prompting a user, specifically stating that “the request to the web user occurs dynamically, e.g., automatically after the HTML document is downloaded.” Since the rejected claims already referred to “commencing to download a file,” the most logical manner for amending these claims to clarify this temporal relationship was to reuse the language already in the claims, i.e., by clarifying that the dynamic prompting occurred “after commencing to download the file.”

Applicant notes that the standard for §112, first paragraph is whether the specification reasonably conveys to one skilled in the art that the inventor had possession of the claimed invention. The standard does not require claim language to be found verbatim in the specification, instead, the standard is based upon what one skilled in the art would understand from a reading of the specification. The concepts of commencing to download a file, dynamically prompting a user, and doing so after download of a file has been commenced are all disclosed clearly in the specification, drawings and claims as originally filed. Therefore, Applicant submits that one skilled in the art would readily appreciate that Applicant had possession of the claimed invention, and thus, the rejected claims are in compliance with §112, first paragraph. Reconsideration and withdrawal of the §112, first paragraph rejections of claims 38, 50, 61 and 75 are therefore respectfully requested.

Next, with respect to the objection to the language “tangibly embodied,” the Examiner will note that claim 61 has been amended to remove this language. While Applicant traverses the §112 rejection with respect to this language, this rejection has been rendered moot by virtue of the amendment.

Next, with respect to the art-based rejections, and in particular the rejection of claim 38, this claim recites an apparatus that includes at least one processor; a memory coupled to the at least one processor; and a computer program residing in the memory, said computer program commencing to download a file referencing a plurality of components, said computer program dynamically prompting a user to select which of said plurality of components to download after commencing to download the file.

As has been established by Applicant both as a result of a consistent usage throughout the prosecution history, and as a result of the Decision of the Board of Appeals, a "component" referenced by a file being downloaded does not correspond to hypertext links to other files that may be present in a particular file being downloaded.

Applicant defines "components" in the specification as "any item referenced in [an] HTML page to be downloaded and integrated with the page, such as graphics images, background images, audio, video and multimedia files, forms, applets, etc." (Application, page 7, lines 12-15, *emphasis added*). Based upon this definition, a hypertext link defined in a hypertext document, which references a different hypertext document that will be retrieved and displayed upon selection of the hypertext link, is not a "component" in the context of Applicant's invention.

This particular interpretation of the term "component" was accepted by the Board of Patent Appeals and Interferences in the Decision dated June 22, 2004. Specifically, the Board favorably cites page 2 of the Specification, which states:

"Many web pages use extensive graphics and other "components" to dress up their web page, where components are defined in this patent to be any additional items referenced in HTML documents. These components are included in an HTML document through the use of specialized tags. For example . . . " (Decision, page 5, quoting Application, page 2).

Moreover, the Board indicates that the board considers "components" to be "items referenced in [an] HTML document." *Id.*

In rejecting claim 38, the Examiner continues to rely on Murata, although the Examiner now cites different passages in the reference: col. 1, lines 10-35, col. 5, line 35 to col. 6, line 8, col. 13, lines 5-29, col. 14, lines 3-62 and Figs. 5, 46 and 48.

Murata discloses two principal types of embodiments. The first is generally directed to the use of a “summary file” that is either embedded in an HTML file or linked to by an HTML file, and is used to describe or summarize a different HTML file that is linked to by the HTML file within which the summary file is either embedded or linked. Essentially, the summary file describes another HTML file so that a user can determine whether they would like to download that HTML file before the file is ever downloaded. Thus, for example, an HTML file A may include a link to an HTML file B, as well as a summary file that enables a user to view summary information about HTML file B while HTML file A is being displayed. Based upon the summary information, the user can make a more informed decision as to whether he or she wishes to select the link to HTML file B and download that file.

The second type of embodiment, disclosed beginning with Fig. 42 and col. 12, is directed to the concept of adding a home page to a “path” of home pages that a user wishes to create in order to view a collection of home pages in a particular sequence. The concept of generating a path of home pages is irrelevant to the claimed invention, for no other reason than the home pages are not even arguably components of one another. Rather, they are completely separate web pages.

It should be noted that, based upon the accepted construction of the concept of a “component” (a construction from which the Examiner is estopped from deviating by the Board Decision), whenever an HTML file is displayed in Murata, and summary information is presented about other HTML files linked to by the displayed HTML file, the other HTML files cannot be interpreted as “components” of the HTML file being displayed. Thus, any rejection of claim 38 that analogizes the other HTML files to “components” of the displayed HTML file in Murata cannot be sustained.

The Examiner attempts to assert that Fig. 5, steps S4 and S6, Figs. 46 and 48, col. 5, line 36 to col. 6, line 8, col. 13, lines 5-29, and col. 14, lines 3-62 discloses “dynamically

prompting a user to select which of said plurality of components to download after commencing to download the file.”

The passages in Fig. 5 and col. 5, line 36 to col. 6, line 8, however, refer to the download of a summary file that is related to an HTML file, before the HTML file itself is ever downloaded. Col. 5, lines 30-32, which describes Fig. 5, states “[i]n this embodiment, the summary of the related information is displayed before the related information is accessed from the file.” This “related information” is specifically described as being a separate HTML file, as cols. 5-10, and Figs. 5-10, refer repeatedly to an HTML file A and HTML file B.

While the logic used in the rejection is somewhat unclear, it appears that the Examiner may be attempting continuing to analogize the separate HTML files, which are described by embedded summary information, to “components” of the displayed HTML file. As noted above, however, such a construction would be inconsistent with the accepted construction of a component, and as such, the rejection would be in error. In the alternative, it may be that the Examiner is considering the summary information itself to correspond to a “component.” However, whether the summary information is embedded in the displayed HTML file, or provided in a separate HTML file, the summary information is always downloaded with the original HTML file. Thus, there is no “dynamic prompting” that occurs with respect to the summary information, and a rejection of claim 38 that relies on such a construction would likewise be in error.

The remaining passages, in Figs. 46 and 48, col. 13, lines 5-29, and col. 14, lines 3-62, are completely irrelevant to the claimed invention. Fig. 46, and the accompanying disclosure at col. 13, lines 5-29, describes an “eighth embodiment” where a window is displayed including a “path” of web pages. A user can click on one of the circles representing a web page in order to download the web page, and can push an arrow button to download earlier or later web pages along the path. Of note, however, all of these web pages are separate web pages, and are not “components” of one another. Fig. 48, and the accompanying passage at col. 14, lines 3-62, discloses a “dynamic information read section” that tracks the congestion status of the network and the number of times pages

have been accessed to determine which page along a path should be downloaded next. Of note, this passage, while referencing the term “dynamic” does not even prompt a user, much less prompt a user for components to download. In addition, as with Fig. 46, the web pages are all separate pages, and are not components of one another. Thus, these passages do not disclose “dynamically prompting a user to select which of said plurality of components to download after commencing to download the file,” as required by claim 38.

In responding to Applicant’s prior arguments, the Examiner makes several arguments in rebuttal at page 2 of the Office Action. First, the Examiner states that Applicant argues that the prior art does not teach or suggest a component such as graphic images, audio, video, multimedia files, forms, applets, etc. With all due respect, the Examiner is misstating Applicant’s argument, as Applicant has never alleged that components themselves are patentable, as conventional web browsers have from the very beginning had the capability to download HTML files with embedded components such as images and the like. Claim 38 is directed in part to “dynamically prompting a user to select which of [a] plurality of components to download after commencing to download the file,” which distinguishes from conventional web browsers that automatically download all components referenced by an HTML file whenever the file is first downloaded. The Examiner has still not shown where in Murata a user is ever dynamically prompted to select which of a plurality of components that are referenced in an HTML file should be downloaded, where that dynamic prompting occurs after downloading of that HTML has been commenced.

Second, the Examiner asserts that Applicant argues that the prior art does not teach or suggest “dynamic prompting.” Again, with all due respect, the Examiner is misstating Applicant’s argument, as Applicant has never claimed ownership in the concept of dynamically prompting a user for every conceivable purpose. Claim 38 is directed in part to “dynamically prompting a user to select which of [a] plurality of components to download after commencing to download the file,” and none of the passages cited by the Examiner disclose any such functionality. The sub window referenced in Fig. 5 displays summary information for a different file, and is displayed before the file itself is ever downloaded. The dynamic information read section in Fig. 48 is not even a dynamic

prompt of a user, it is instead a way of tracking congestion and usage statistics to determine which page along a path to download, and the path display in Fig. 46 enables a user to select any page along a path to download. As noted above, however, the pages along the path are not properly analogized to components of one another. When the concept of a “component” is properly construed in accordance with the findings of the Board, none of the cited passages can be found to anticipate claim 38. The Examiner has simply not shown where in Murata a user is ever dynamically prompted to select which of a plurality of components that are referenced in an HTML file should be downloaded, where that dynamic prompting occurs after downloading of that HTML has been commenced.

Third, the Examiner argues that Murata discloses “select[ing] information after download.” As noted above, however, the summary information the Examiner apparently analogizes to a component is not properly considered a component of a file, and regardless, summary information is always downloaded within another file. A user may be prompted to display summary information, but that information has already been downloaded. No prompting ever occurs as to whether to download any summary information. Claim 38 is not directed to prompting a user to display information, but is instead directed to prompting a user to download information. Murata does not disclose any such configuration, so whether or not the cited passages disclose prompting a user to display information is irrelevant to the claimed invention.

Fourth, the Examiner attempts to discount the concept of dynamic prompting after downloading a file has commenced, stating the language is not described in the specification. As Applicant established above in connection with the §112, first paragraph, there is ample support in the specification for this language, so this language is properly considered in evaluating the patentability of the claim.

Applicant therefore respectfully submits that Murata does not disclose the combination of “commencing to download a file referencing a plurality of components,” and “dynamically prompting a user to select which of said plurality of components to download after commencing to download the file,” as required by claim 38. Claim 38 is therefore novel over Murata, and the rejection should be withdrawn. In addition, the



Examiner has presented no objective reason why one of ordinary skill in the art would be motivated to modify Murata to incorporate Applicant's claimed combination of features. As such, no *prima facie* case of obviousness has been established for claim 38, and claim 38 is therefore patentable over the prior art of record. Reconsideration and allowance of claim 38, and of claims 39-49 which depend therefrom, are therefore respectfully requested.

Next, with respect to independent claims 50, 61 and 75, each of these claims recites, to varying extents, the concept of dynamically prompting a user to select which of a plurality of components referenced in a file to download after commencing to download that file. As discussed above in connection with claim 38, Murata does not disclose or suggest the combination of commencing to download a file or document referencing a plurality of components, and dynamically prompting a user to select which of the components to download after commencing to download the file or document. Claims 50, 61 and 75 are therefore novel and non-obvious over Murata for the same reasons as discussed above for claim 38. Reconsideration and allowance of these claims, and of claims 51-60, 62 and 65-72 which depend therefrom, are therefore respectfully requested.

Next, with respect to independent claims 73 and 74, claim 73 recites in part a component download selection mechanism that "dynamically creat[es] a component download selection list when an HTML document with a plurality of components is downloaded," and that "prompt[s] a user to select which of said plurality of components to download." Likewise, claim 74 recites in part "requesting [an] HTML document from [a] web server," "parsing said HTML document for references to [a] plurality of embedded components," and "prompting a user to select which of said plurality of embedded components to download by displaying a component download selection list on [a] web browser." Therefore, in both claims, the dynamic prompting of the user occurs after at least a portion of the document that references the components has been retrieved or downloaded. Therefore, as with the other independent claims discussed above, Murata falls short as an anticipatory reference, because Murata does not disclose any embodiment in which a user is prompted to select components from a file to download after downloading of the file itself has been commenced. Claims 73 and 74 are therefore novel

over Murata, and the rejections thereof should be withdrawn. Reconsideration and allowance of claims 73 and 74 are therefore respectfully requested.

As a final matter, Applicant traverses the Examiner's rejections of the dependent claims based upon their dependency on the aforementioned independent claims. Nonetheless, Applicant does note that a number of these claims recite additional features that further distinguish these claims from the references cited by the Examiner. However, in the interest of prosecutorial economy, these claims will not be addressed separately herein.

In summary, Applicant respectfully submits that all pending claims are novel and non-obvious over the prior art of record. Reconsideration and allowance of all pending claims are therefore respectfully requested. If the Examiner has any questions regarding the foregoing, or which might otherwise further this case onto allowance, the Examiner may contact the undersigned at (513) 241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

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Date

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